

## **REMARKS/ARGUMENTS**

The Applicants originally submitted Claims 1-20 in the application. The Applicants have previously amended Claims 1 and 8, and have canceled Claims 3 and 10. Presently, the Applicants have neither amended nor canceled any Claims. Accordingly, Claims 1-2, 4-9 and 11-20 are currently pending in the application.

### **I. Rejection of Claims 1-2, 8-9 and 15-16 under 35 U.S.C. §103**

The Examiner has rejected Claims 1-2, 8-9 and 15-16 under 35 U.S.C. §103(e) as being unpatentable over U.S. Patent No. 6,219,539 to Kalyan Basu, *et al.* ("Basu") in view of U.S. Patent No. 6,122,271 to McDonald, *et al.* ("McDonald"). The Applicants respectfully disagree.

The Examiner has stated that Basu discloses communicating data over a voice channel between a transmitter and a receiver, wherein the transmitter is associated with a base station of a cordless telephone and the receiver is associated with a handset of the cordless telephone. (Examiner's Action, Page 2). Basu does not teach or suggest communicating data over a voice channel. Basu only teaches transmitting data over a control channel and transmitting voice over a separate voice channel. More specifically, Basu maintains lists of available control frequencies and voice channel frequencies. (Column 9, lines 27-28). Basu also states that a control message is transmitted from the base station across a private AMPS control channel to the mobile station so that the mobile station can select that same control channel and transmit its control information back to the base station. (Column 9, lines 35-39). In addition, Basu states, in regard to a simple cordless function or an outgoing call, the control channel carries the called number to the base station. The base station then initiates a call set-up function to the PSTN and allocates a voice channel to the

mobile station. (Column 9, lines 47-51). Therefore, Basu only teaches that it uses a control channel that is separate from the voice channel to communicate data between the base station and the mobile station.

According to the invention disclosed in Basu, Basu must use a separate control channel for communicating data instead of a voice channel. Basu uses the control channel to determine when to switch systems. More specifically, if the control channel does not exist, Basu will then start scanning for the CDMA system. (Column 10, lines 35-37). This allows the mobile station to switch from the home base station to the cellular (CDMA) system. (Column 10, lines 19-49). Therefore, Basu fails to teach or suggest communicating data over a voice channel as recited in Claims 1, 8 and 15.

The Examiner has also stated that Basu fails to teach or suggest a silence detector, coupled to the transmitter, that identifies a pause in voice traffic that is to be transmitted over the voice channel and generates an interjection signal during the pause, and a data injector, coupled to the silence detector, that receives the interjection signal and responds by causing the transmitter to transmit data to the receiver over the voice channel. (Examiner's Action, Pages 2-3). The Examiner has cited McDonald only for the premise of teaching a silence detector, coupled to the transmitter, that identifies a pause in voice traffic that is to be transmitted over the voice channel and generates an interjection signal during the pause, and a data injector, coupled to the silence detector, that receives the interjection signal and responds by causing the transmitter to transmit data to the receiver over the voice channel. (Examiner's Action, Page 3). The Examiner further stated that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of McDonald with the teaching of Basu in order to provide voice and data messages communication

between devices without using a dedicated frequency of a dedicated time slot. (Examiner's Action, Page 3). The Applicants respectfully disagree.

McDonald merely teaches interjecting a digital message in a silence period of a digital speech frame to be transmitted on a channel. (McDonald, Column 3, line59, through Column 4, line15). The teachings of McDonald, however, cannot be combined with the teachings of Basu, because Basu requires a control channel that is separate from its voice channel. As discussed above, Basu uses the existence of the control channel to determine whether to start scanning for a CDMA system. (Basu, Column 10, lines 35-37). If the teachings of McDonald were applied to Basu, all of the control data would be moved from its separate control channel and transmitted over the voice channel of Basu, which would eliminate the control channel currently used in Basu. The system of Basu, however, would now be unable to determine if it needs to start scanning for the CDMA system since the separate control channel is no longer available to Basu. In addition, moving all of the control and message data of Basu to the voice channel would defeat the purpose of Basu's invention of being able to switch automatically between an in-house cordless phone and a wireless mobile phone that uses the cellular networks. Therefore, the combination of McDonald with Basu is improper and would fail to provide the requisite motivation to develop the Applicants' claimed invention as recited in Claims 1, 8 and 15. The Applicants therefore respectfully traverse the Examiner's rejection of Claims 1-2, 8-9 and 15-16 under 35 U.S.C. §103.

## **II. Rejection of Claims 5, 12 and 18 under 35 U.S.C. §103**

The Examiner has rejected Claims 5, 12 and 18 under 35 U.S.C. §103(e) as being anticipated by Basu in view of McDonald and in further view of U.S. Patent No. 6,014,569 to Joshua

Bottum. As discussed above, Basu in view of McDonald fails to teach or suggest all of the elements of the inventions recited in independent Claims 1, 8 and 15. The Examiner has cited Bottum only for the premise of teaching the dependent Claims 5, 12 and 18. Since Basu and McDonald fail to teach or suggest all of the elements of the inventions of Claims 1, 8 and 15, as explained above, and Bottum fails to cure the deficiencies, the Examiner cannot establish a *prima facie* case of obviousness of dependent Claims 5, 12 and 18, which include the elements of the respective independent claims. The Applicants therefore respectfully traverse the Examiner's rejection of Claims 5, 12 and 18 under 35 U.S.C. §103.

### **III. Rejection of Claims 7, 14 and 20 under 35 U.S.C. §103**

The Examiner has rejected Claims 7, 14 and 20 under 35 U.S.C. §103(e) as being unpatentable over Basu in view of McDonald and in further view of U.S. Patent No. 6,041,227 to Terence Edward Sumner. As discussed above, Basu in view of McDonald fails to teach or suggest all of the elements of the inventions recited in independent Claims 1, 8 and 15. The Examiner has cited Sumner only for the premise of teaching the dependent Claims 7, 14 and 20. Since Basu and McDonald fail to teach or suggest all of the elements of the inventions of Claims 1, 8 and 15, as explained above, and Sumner fails to cure the deficiencies, the Examiner cannot establish a *prima facie* case of obviousness of dependent Claims 7, 14 and 20, which include the elements of the respective independent claims. The Applicants therefore respectfully traverse the Examiner's rejection of Claims 7, 14 and 20 under 35 U.S.C. §103.


**IV. Conclusion**

In view of the foregoing remarks, the Applicants now see all of the Claims currently pending in this application to be in condition for allowance and therefore earnestly solicit a Notice of Allowance for Claims 1-2, 4-9 and 11-20.

The Applicants request the Examiner to telephone the undersigned attorney of record at (972) 480-8800 if such would further or expedite the prosecution of the present application.

Respectfully submitted,

HITT GAINES, P.C.

A handwritten signature in black ink, appearing to read "Mark E. Kelley", with a long, sweeping horizontal stroke extending to the right.

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